

REMARKS

Claims 15 to 18 are added, and therefore claims 7 to 18 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 7 to 9 are rejected under 35 U.S.C. § 102(b) as anticipated by Beck et al. ("the Beck reference"), U.S. Patent No. 6,560,088.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 7 is directed to a method for activating a two-stage switching valve including a first stage having a smaller flow cross section and a second stage having a larger flow cross section, the switching valve being situated between a main brake cylinder and a hydraulic pump in a hydraulic brake system, the method comprising: activating the switching valve in a first phase by a control signal having a small amplitude to first open only the first stage of the switching valve for a predetermined period of time; and activating the switching valve in a second phase by the control signal having a higher amplitude.

The Beck reference relates to a method and a circuit arrangement for reducing the level of noise produced during actuation of an electromagnetically actuated device, including an electromagnet which is driven with a controlled current progression whereby a first portion of the current increase is carried out with a steep current increasing characteristic, and a second portion of the current increase is carried out with a more gradual variation of the current.

It is believed and respectfully submitted that the Beck reference does not identically disclose (or suggest) the feature of *a first stage having a smaller flow cross section and a second stage having a larger flow cross section*, as provided for in the context of the presently claimed subject matter.

Accordingly, it is respectfully submitted that claim 7 is allowable for at least the reasons provided above, as are its dependent claims 8 and 9.

Withdrawal of the rejections of these claims is therefore respectfully requested.

Claims 10 to 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over the Beck reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art

Application Serial No. 10/580,883
Atty. Docket No. 10191/4207
Reply to Office Action of August 4, 2010

reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Beck reference does not disclose or even suggest all of the features of claim 7, so that it is allowable, as are its dependent claims 10 to 14.

Withdrawal of the rejections of these claims is therefore respectfully requested.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

In sum, it is respectfully submitted that claims 7 to 15 are allowable.

New claims 15 to 18 do not add any new matter and is supported by the present application, including the specification. Claims 15 to 18 ultimately depend from claim 7, and they are therefore allowable at least for the same reasons.

Accordingly, it is respectfully submitted that claims 7 to 18 are allowable.

Application Serial No. 10/580,883
Atty. Docket No. 10191/4207
Reply to Office Action of August 4, 2010

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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